

REMARKS/ARGUMENTS

This response is submitted in response to the Office Action dated April 10, 2006. Reconsideration and allowance is requested.

Claims 1, 5-10, 23-25, 27 and 33 remain in this application.

Formal Matters

In the Office Action, the Examiner used Dor et al (US 6,744,266 B2) as a prior art reference, along with several other references, to reject all the pending claims under 35 USC 103(a). Counsel for assignee does not believe that Dor et al is prior art for this pending application. Since this pending application was filed on March 30, 2001 and claims priority to Japanese Patent Application No. 00-152663 filed on May 18, 2000, the priority date for this application is May 18, 2000. Dor et al was filed on July 13, 2001 and claims priority to provisional application 60/237,297 filed on October 2, 2000. Therefore this application has an earlier priority date than Dor et al. and Dor et al is not prior art for this pending application. In light of these remarks, counsel for assignee respectfully requests that the Examiner reconsider all the rejections based on Dor et al.

Claim Rejection under 35 USC 103

In the Office Action, the Examiner rejected claims 1, 5, 6, 8, 9, 27, and 33 under 35 USC 103(a), as being unpatentable over Dor et al (US 6,744,266 B2) in view of Stephan et al (US 6,338,001 B1), further in view of Nishimura et al (US 5,761,337) further in view of Kumagai (US 5,394,481), further in view of Jarvis et al (US 6,297,644 B1). The Examiner also used Dor et al to reject claims 7, 10, and 23-25. Counsel for assignee respectfully traverses. As explained above, Dor et al is not prior art. The Examiner argued that:

Newly cited Dor discloses a defect classification system having computer displays that display defect image data along with first, second, and third classification data, as described above. Stephan is used for teaching the use of kill ratios in wafer defect analysis. Kumagai and Nishimura are used for teaching various defect types that are used for defect classification. Jarvis is used for the

teaching of using voltage contrast instrumentation on an SEM for gathering and calculating further defect data.


In order to establish *prima facie* obviousness the prior art references (or references when combined) must teach or suggest all of the claimed limitations. See *In re Vaeck* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2143. Since Dor et al was the main reference used to reject all of the claims and since Dor et al is not prior art, counsel for assignee does not believe that the prior art references teach all of the claimed limitations. Since Dor et al is not prior art, Stephan, Nishimura, Kumagai, and Jarvis are the only remaining references used in the rejections. However, in the previous office action, independent claims 1, 6, and 9 were already further amended to distinguish them from Stephan, Nishimura, Kumagai, and Jarvis. Since the claims were already amended to be further distinguishable from these same reference, counsel for assignee does not believe that these same remaining references can make up all the deficiencies left by removing Dor et al as a reference. Therefore, since Dor et al. is not prior art for this pending application, as explained above, the remaining references do not teach each and every element of the claims and counsel for assignee does not believe that the pending claims are obvious, under *In re Vaeck* and MPEP 2143.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,


Jesus Del Castillo
Reg. No. 51,604

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor, San Francisco, CA 94111-3834
Tel: 650-326-2400 / Fax: 415-576-0300
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